

#28
12/4/03
mh

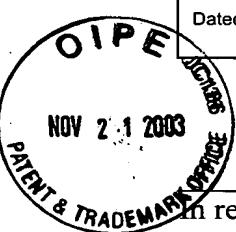
I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256030406US, in an envelope addressed to: MS Board of Patent Appeals and Interferences; Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: November 21, 2003

Signature:


(Lisa deCordova)

Docket No.: 49581/P006US/09604915
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Adam S. Wyszynski

Application No.: 08/579,072

Filed: December 22, 1995

For: SIGNAL-TO-NOISE OPTIMIZED FULLY
MONOLITHIC VIDEO RECEIVER IF
CHANNEL

Art Unit: 2684

Examiner: N. Maung

BOARD OF
PATENT APPEALS
AND INTERFERENCES
ST. 2 NOV 2003
RECEIVED
U.S. PATENT AND TRADEMARK OFFICE
JULY 2004

REQUEST FOR REHEARING UNDER 37 C.F.R. 1.197(b)

Mail Stop Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant respectfully requests that the Board of Patent Appeals and Interferences grant a rehearing in appeal number 2001-1790 and modify the decision issued September 22, 2003 in light of the following.

BRIEF SUMMARY OF ACTIONS

The present application was filed December 22, 1995, having claims 1-21. A first Office Action was mailed October 19, 1997, which rejected claims 1-21. More specifically, claims 1-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamamoto (United States patent number 5,361,395, hereinafter *Yamamoto*) in view of Umezawa et al. (United States patent number 5,491,507, hereinafter *Umezawa*), claims 13, 15-18, 20 and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Yamamoto*, and claims 14 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yamamoto*. A Final Office Action was mailed March 3, 1998, that maintained the rejection of claims 1-12 as

being unpatentable under 35 U.S.C. § 103(a) over *Yamamoto* in view of *Umezawa*, and which rejected claims 13-21 under 35 U.S.C. § 103(a) over *Yamamoto* in view of *Kaschke* (United States patent number 5,555,550, hereinafter *Kaschke*).

Appellants filed a Notice of Appeal on July 2, 1998, appealing this case to the Board of Patent Appeals and Interferences (“the Board”). In the appeal, Appellant took issue, *inter alia*, with the Appellee’s rejection of independent claims 1 and 7, and the claims dependent therefrom, under 35 U.S.C. § 103(a), arguing that the Appellee’s applied combination of *Yamamoto* in view of *Umezawa* failed to teach all elements of claims of these claims. The Board rendered its decision September 22, 2003, affirming the Appellee’s rejection with respect to claims 1 and 7.

In affirming the Appellee’s rejection of claims 1 and 7, the Board states that “[w]hile appellant’s representative offered interesting arguments during a telephonic hearing on September 9, 2003, regarding *Yamamoto*’s inability to process video signals (which, if true, would offer substantial evidence tending towards the unobviousness of applying a video signal to the circuit of *Yamamoto*), we note that such argument does not appear in the briefs,” Decision on Appeal at pages 5 and 6. The Board did not consider Appellant’s argument regarding *Yamamoto*’s inability to process video signals in the Decision, stating that the Appellee has not had an opportunity to respond to this argument. However, as discussed further below, the Board essentially issued a new ground of rejection during the telephonic hearing, to which Appellant responded with the foregoing argument. Although the Appellee may not have had an opportunity to respond to the above mentioned argument, Appellant has not had a full and fair opportunity to respond to the rejection of claims 1 and 7 as stated by the Board in the telephonic hearing of September 9, 2003, due to the Board not considering Appellant’s argument in response to the new rejection. Accordingly, Appellant respectfully requests that a rehearing be granted under 37 C.F.R. § 1.197(b).

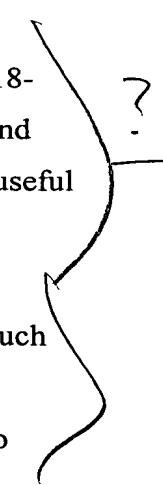
REMARKS

In rejecting claims 1 and 7 under 35 U.S.C. § 103(a) over *Yamamoto* in view of *Umezawa*, the Appellee asserts that it would have been obvious to one of ordinary skill in the art to include video signals as shown in *Umezawa* in order that a user can receive not only voice signals, but also video signals, the Final Office Action at page 3. As *Yamamoto* teaches

only an automatic gain control circuit, such as may be utilized in mobile telephone systems, the Appellee's rejection of record requires combining video processing and display circuits of *Umezawa* with the automatic gain control circuit of *Yamamoto* in order that "a user of the phone can receive not only voice signal, but also the user can receive a video signal," id. Accordingly, Appellant addressed the patentability of claims 1 and 7 with reference to modification of *Yamamoto* in view of *Umezawa* to include video signal processing circuitry with the audio processing circuitry of *Yamamoto* to allow a user to receive both voice and video signals, Appeal Brief at pages 6-8 and 9-10.

In the telephonic hearing of September 9, 2003, the Board posed the question to Appellant's representative regarding patentability of claims 1 and 7 in light of the recited video signal processing aspect of the claims as why one of ordinary skill in the art would not have applied a video signal to antenna 11 of *Yamamoto*. This characterization of the applied art provides a modification to the *Yamamoto* circuit resulting in video signal processing being performed instead of the audio processing disclosed in *Yamamoto*, contrary to the Appellee's stated modification wherein a user receives voice signals and video signals. In its Decision of September 22, 2003, the Board relies upon the foregoing modification to *Yamamoto* in affirming Appellee's rejection of the claims. However, the Board has essentially issued a new ground of rejection, to which Appellant has not had the opportunity to respond due to Appellant's argument in response not being considered by the Board.

As conceded by the Board in its Decision of September 22, 2003, Appellant's representative set forth argument offering substantial evidence tending towards the unobviousness of applying a video signal to the circuit of *Yamamoto* in response to the foregoing new ground of rejection. For example, *Yamamoto* expressly teaches that the demodulated signal is output from a loud-speaker in the form of voice (column 4, lines 18-21), and therefor provides audio output circuitry (see Audible Frequency Amplifier 19 and Speaker 20 of Figure 1). Accordingly, the circuit of *Yamamoto* would not perform any useful function when having a video signal applied to antenna 11 thereof without substantial unsuggested modification, such as to provide some form of undisclosed video output circuitry. Moreover, video signals are appreciably different than typical audio signals, such as those for which the audio circuitry of *Yamamoto* is designed, in several regards. For example, video signals generally comprise a larger channel bandwidth than typical audio



signals. Accordingly, bandpass filters 15 and 17 of *Yamamoto*, taught to remove signal components having frequencies other than a predetermined frequency band associated with the expected audio signal (see e.g., column 4, lines 9-18) would require unsuggested modification in order to accommodate the application of a video signal to antenna 11 as proffered by the Board.

In light of the foregoing, Appellant respectfully requests that rehearing be granted under 37 C.F.R. § 1.197(b) and that the Board reverse the Appellee's rejection of claims 1 and 7, and the claims dependent therefrom, based upon Appellant having provided substantial evidence showing the unobviousness of the claims in response to both the Appellee's stated ground of rejection and the Board's proffered new ground of rejection. Alternatively, Appellant requests that rehearing be granted under 37 C.F.R. § 1.197(b) and that the Board remand the decision with respect to patentability of claims 1 and 7, and the claims dependent therefrom, to the Appellee for Appellant to have a full and fair chance to address the new ground of rejection before Appellee.

Applicant believes no petition fee is due with this request. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 49581/P006US/09604915 from which the undersigned is authorized to draw.

Dated: November 21, 2003

Respectfully submitted,

By R. Ross Viguet
R. Ross Viguet
Registration No.: 42,203
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8185
(214) 855-8200 (Fax)
Attorney for Applicant



11-24-03 Bd of Appeal AF/2684

PTO/SB/21 (08-03)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

| | | | |
|--|---|------------------------|-----------------------|
| | | Application Number | 08/579,072 |
| | | Filing Date | December 22, 1995 |
| | | First Named Inventor | Adam S. Wyszynski |
| | | Art Unit | 2684 |
| | | Examiner Name | N. Maung |
| Total Number of Pages in This Submission | 5 | Attorney Docket Number | 49581/P006US/09604915 |

ENCLOSURES (Check all that apply)

| | | |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form | <input type="checkbox"/> Drawing(s) | <input type="checkbox"/> After Allowance Communication to Group |
| <input type="checkbox"/> Fee Attached | <input type="checkbox"/> Licensing-related Papers | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences |
| <input type="checkbox"/> Amendment/Reply | <input type="checkbox"/> Petition | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input type="checkbox"/> Status Letter |
| <input type="checkbox"/> Extension of Time Request | <input type="checkbox"/> Terminal Disclaimer | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcards Request for Rehearing Under 37 C.F.R.1.197(b) |
| <input type="checkbox"/> Express Abandonment Request | <input type="checkbox"/> Request for Refund | |
| <input type="checkbox"/> Information Disclosure Statement | <input type="checkbox"/> CD, Number of CD(s) _____ | |
| <input type="checkbox"/> Certified Copy of Priority Document(s) | | |
| <input type="checkbox"/> Response to Missing Parts/ Incomplete Application | | |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | | |
| Remarks | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|-------------------------|---|
| Firm or Individual name | FULBRIGHT & JAWORSKI L.L.P. R. Ross Viguet |
| Signature | |
| Date | November 21, 2003 |

Transmittal

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256030406US, in an envelope addressed to: MS Board of Patent Appeals and Interferences, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: November 21, 2003

Signature: (Lisa deCordova)